REMARKS

This is a full and timely response to the non-final Office Action mailed on February 10, 2005 (Paper No./Mail Date 20050204). Accordingly, claims 1, 3-5, 7-8, 18-21, 27, 30, 32, and 37-58 are currently pending in the Application. Reconsideration and allowance of the Application and presently pending claims are respectfully requested in view of the foregoing remarks. Applicant should not be presumed to agree with any statements made by the Examiner in the Office Action unless otherwise specifically indicated by Applicant.

I.   Response to Claim Rejections Under 35 U.S.C. §112, First Paragraph

Claims 2, 9-17, and 33-35 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicant respectfully submits that the claims have been canceled and thus, respectfully requests the rejection be withdrawn.

II.   Response to Claim Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 22-25 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being incomplete for omitting essential steps, such omission amounting to a gap between the steps. Applicant respectfully submits that the claims have been canceled and thus, respectfully requests the rejection be withdrawn.

III.   Rejection under 35 U.S.C. 103(a)

Claims 1, 3-5, 7, 8, 18-28, 30, 32-35, and 37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,890,319, to *Seth-Smith*.

It is well established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a single reference, the reference must disclose, teach, or suggest, either implicitly or explicitly, all elements/features/steps of the claim at issue. *See, e.g., In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

A.   Claim 1

Claim 1, as amended, recites:

> A media services device, comprising:
> a memory for storing subscriber identification information; and
> a processor configured to receive the subscriber identification information and a media presentation, *wherein the subscriber identification information is received via a graphical user interface,* wherein the processor is further configured to insert the subscriber identification information into the media presentation, wherein the processor is located in a media services client device, wherein the processor is configured to insert the subscriber identification information into the media presentation during a vertical blanking interval of the presentation of the media presentation, wherein the subscriber identification information is invisible to a viewer of the media presentation.

(Emphasis Added)

Seth-Smith apparently discloses storing subscriber identification information as a pre-assigned subscriber identification which presumes that a service provider pre-assigns the subscriber identification information to a client device. Nowhere does *Seth-Smith* disclose receiving subscriber identification information via a graphical user interface as recited in claim 1. Consequently, Applicant respectfully requests that claim 1 be allowed and the rejection be withdrawn.

B.   Claim 19

Claim 19, as amended, recites:

> A method for inserting subscriber identification information into media presentations, the method comprising steps of:
> *receiving subscriber identification information via a graphical user interface;*
> storing the subscriber identification information in memory;
> receiving a subscriber request for a media presentation; and
> inserting the subscriber identification information into the media presentation requested by a subscriber, wherein the inserting of the subscriber identification information occurs at a media

services client device, wherein the media services client device inserts the subscriber identification information into the media presentation during a vertical blanking interval of a presentation of the media presentation, wherein the subscriber identification information is invisible to a viewer of the media presentation.

(Emphasis Added)

As mentioned above, *Seth-Smith* apparently discloses storing subscriber identification information as a pre-assigned subscriber identification which presumes that a service provider pre-assigns the subscriber identification information to a client device. Nowhere does *Seth-Smith* disclose receiving subscriber identification information via a graphical user interface as recited in claim 19. Consequently, Applicant respectfully requests that claim 19 be allowed and the rejection be withdrawn.

C. Claims 3-5, 7-8, 18, 20-21, 27, 30, 32, and 37

Because independent claims 1 and 19 are allowable over the cited art of record, dependent claims 3-5, 7-8, 18, 20-21, 27, 30, 32, and 37 are allowable as a matter of law for at least the reason that dependent claims 3-5, 7-8, 18, 20-21, 27, 30, 32, and 37 contain all features and elements of their respective independent base claim. *See, e.g., In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, Applicant respectfully requests that the rejection to dependent claims 3-5, 7-8, 18, 20-21, 27, 30, 32, and 37 be withdrawn for at least this reason, among others.

D. Newly Added Claims 38-57

Claims 38-58 have been newly added. The newly added claims 38-58 are adequately supported by the specification. Consideration of new claims 38-58 is respectfully requested. The references cited in the Office Action do not disclose, teach, or suggest any of the newly added claims 38-58.

Claims 38-49 are allowable for at least the reason that none of the cited references teach, suggest, or disclose that a media services server device that includes "a processor configured to transmit the subscriber identification information and a media presentation via a network, wherein the processor is configured to insert the subscriber identification information into the

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media presentation, wherein the subscriber identification information is invisible to a viewer during the display of the media presentation."

Claims 50-58 are allowable for at least the reason that none of the cited references teach, suggest, or disclose that "storing the subscriber identification information in memory at a media services server device; inserting the subscriber identification information into the media presentation requested by a subscriber, wherein the inserting of the subscriber identification information occurs at the media services server device; and transmitting the subscriber identification information from the media services server device via a network."

IV.   Finding of Inherency

The Office Action has stated that "It is obvious to one skilled in the art that since the template/flag is completed by inserting the data that the insertion is performed during the vertical blanking interval of the presentation." The Office Action also stated that "It would be obvious that this signal is an out-of-band signal and that the subscriber identifier must be inherent sent and used in order to identify the correct subscriber." The Office Action also stated that "It is obvious to one skilled in the art that bar-code information on the bar-code chip cannot be rewritten without generating another bar-code chip and is therefore write protected." The Office Action also stated that "It is obvious to one skilled in the art that the information is guarded and used for correlation between the decoder and the secret serial number that the information is write protected."

Applicant respectfully traverses these and any other findings of inherency. It is well established that "[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In Re Anthony J. Robertson*, 98-1270 (Fed. Cir. 1999). Accordingly, Applicant respectfully submits that the subject matter stated to be inherent in the Office Action is not "necessarily" present as stated.
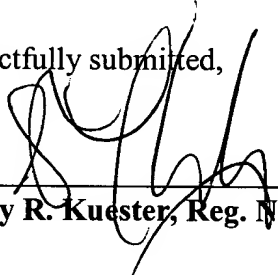
Furthermore, to the extent that any findings would be considered allegations of well-known art, Applicant submits that such should not be considered to be well-known since the

Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all rejections have been traversed and that the now pending claims 1, 3-5, 7-8, 18-21, 27, 30, 32, and 37-58 are in condition for allowance. Favorable reconsideration and allowance of the present application and pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephone conference would expedite the examination of this matter, the Examiner is invited to contact the undersigned agent at (770) 933-9500.

Respectfully submitted,

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